

REMARKS

As a preliminary matter, Applicants traverse the outstanding Office Action as being nonresponsive. Section 707.07(f) of the MPEP places a burden upon the Examiner to, when repeating a previous rejection, first answer all of the meritorious arguments presented by Applicants traversing that rejection. In the present case, this burden has not been met. Although the Examiner now cites Ikeda (U.S. 5,822,785) in combination with the base Wolff reference (U.S. 6,009,427), the Examiner's reliance on Wolff is identical to that in the previous Office Action.

In Amendment B (filed September 11, 2006), however, Applicants expressly challenged this reliance by the Examiner on Wolff. Applicants pointed out how the same cited portions of the reference simply do not describe anything related to all of the features of the present invention asserted by the Examiner. These assertions are repeated in the outstanding Office Action, but the Examiner has not even attempted to respond to Applicants' previous arguments. The Examiner does not rely upon Ikeda to account for this lack of support in the cited portions of Wolff. Accordingly, the outstanding Office Action, and therefore the rejections asserted therein, is deficient, and should be vacated at least for being nonresponsive.

Claim 1 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff in view of Ikeda. Applicants therefore traverse this rejection for at least the reasons of record, those stated above, and as follows. A *prima facie* case of obviousness has not been established against the present invention. The rejection does not identify all of the recited

limitations of the present invention, as required by Section 2143.03 of the MPEP. Furthermore, the rejection fails to identify any teaching or suggestion from the prior art that actually indicates any desirability to combine of the two references, as required by Section 2143.01 of the MPEP. All of Applicants' previous arguments are therefore incorporated by reference herein.

Section 2143.03 requires that the Examiner, when attempting to establish a *prima facie* case of obviousness, must first be able to identify in the prior art where each and every feature and limitation of the claimed invention is taught or suggested. In the present case, however, this requirement has clearly not been met, and Applicants' previous arguments in this regard have not even been challenged by the Examiner. The obviousness rejection of claim 1 is therefore deficient on its face for at least these reasons.

Claim 1 of the present invention features, among other things, that the transmitter-side and the receiver-side storage information management means each manage both a writing start number and a reading end number for use in writing/reading data into the storage device respectively. As in the previous Office Action, the Examiner again cites to only col. 14, lines 48-51 of Wolff for allegedly teaching or suggesting all of these features of claim 1. This very brief portion of the Wolff reference, however, simply fails to support the Examiner's reliance.

The entire text of the cited portion from Wolff is nothing more than a non-grammatical description of one data structure: "A pointer to the beginning of the linked list of Volume_Node_Records 14xx used for searching the list from the start." Even if the

Examiner were correct (which Applicants do not concede) that the cited pointer were even analogous to one of the writing number and reading number of claim 1 (the Examiner does not state which one, if either, he believes is analogous), nothing in this single cited line could be reasonably interpreted to teach anything having to do with an end number, or more particularly, a reading end number, as in claim 1 of the present invention. The cited portion clearly describes only a pointer to the *beginning* of the linked list, and that the list is searched “from the *start*.” The rejection fails to identify any teaching or suggestion relating to an end, or finish. For at least these reasons, the rejection is further deficient under the requirements of Section 2143.03.

The rejection is also separately deficient because nothing in the single cited line from Wolff describes that the cited pointer is also managed by both a transmitter-side and a receiver-side storage information management means, as also clearly featured in claim 1. The Examiner asserts that Wolff’s Clients 54 and 56 are analogous to the transmitter and receiver elements of the present invention, although the Examiner does not specify which. Nevertheless, nothing in the cited line from col. 14 describes, or even suggests, that the pointer is managed by both (or even either) of the Clients 54 and 56. Furthermore, nothing in the cited line of text mentions anything about two such pointers being managed by both Clients. As discussed above, the Examiner has not identified anything in Wolff that could be interpreted to be analogous to both the writing start number and the reading end number of the present invention. Accordingly, the rejection is deficient according to Section 2143.03 for these still further reasons.

The outstanding rejection of claim 1 of the present invention is also separately deficient on its face under the requirements of Section 2143.01. When attempting to combine references in an obviousness rejection, the Examiner is required under Section 2143.01 to also be able to identify where the prior art affirmatively teaches or suggests the actual desirability of making the proposed combination. In the present case, however, this requirement has also clearly not been met. The rejection does not cite any portion of the text from either reference to justify the combination, which is a clear violation of Section 2173.01. The Examiner cites to col. 13, lines 34-48 of Ikeda only for its description regarding a point where a transfer queue read pointer becomes identical with the value of a transfer queue write pointer in a data transfer process. The Examiner does not assert, however, that this paragraph of text from Ikeda also describes how and/or why this particular element of the reference can and should be combined with the very different system described in Wolff. The desirability of making the proposed combination may not just be presumed. Section 2143.01 requires that the Examiner specifically identify where such desirability is actually taught or suggested in the art.

The entire justification submitted on the record to support the proposed combination is the single sentence that “One would have been motivated to [make the combination] in order to ensure that all transfer requests are processed, thereby synchronizing of both write and read pointers.” No explanation is given, however, for how the proposed combination could actually achieve such results, or even that such results will occur. No cited portion from either reference actually teaches or suggests to combine the step from

Ikeda with the teachings of Wolff, as asserted by the Examiner. No cited portion from either reference describes how the proposed combination will “ensure that all transfer requests are processed,” or that the presumed combination will also “synchronize both write and read pointers.” Because this statement does not cite the references, it can, by definition, be only a statement of the Examiner’s own personal opinion. The Examiner’s own personal opinion, however, cannot be used to justify a proposed combination of references.

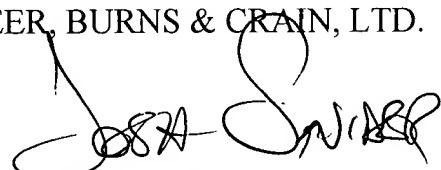
Applicants have already pointed out to the Examiner that his own personal knowledge, experience, and opinions may not be used as the basis to justify what is considered to be obvious. Although in the present Office Action, the Examiner has removed his previous statement that attempted to justify obviousness based only upon the Examiner’s own particular expertise in this field of art, his own personal opinion on this issue, whether expressly stated or not, still remains the only stated justification on the record. Unless the Examiner can cite to where the art itself teaches or suggests the obviousness of making the proposed combination, obviousness simply cannot be established. Again, the Examiner has already expressly stated that he bases his obviousness determination on his own personal opinion and experience. This proposed justification is not changed merely by the removal of the express statement. Removing the invalid justification does not strengthen the case for obviousness unless the Examiner replaced it with a valid, objective justification. The Examiner has not identified any objective support on the record to justify the determination though, and therefore obviousness has not been established. The rejection should thus again be withdrawn.

For all of the foregoing reasons, Applicants submit that this Application, including at least claim 1, is in condition for allowance, which is respectfully requested. The Examiner is invited to contact the undersigned attorney if an interview would expedite prosecution.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By

A handwritten signature in black ink, appearing to read "Josh C. Snider", is written over the printed name.

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